

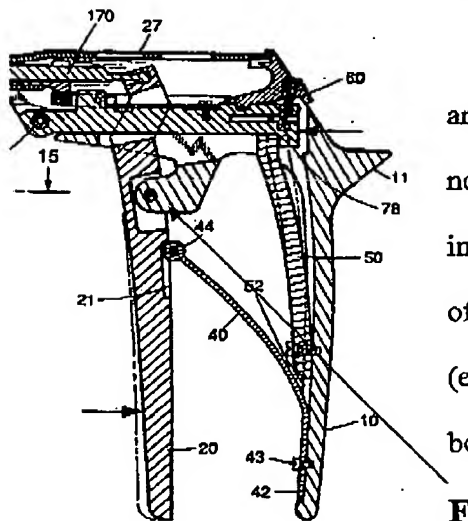
**REMARKS**

Examiner Priddy is thanked for allowing claims 3-31, 59, and 61-70, and for indicating that dependent claims 43, 45-49, 51-54, and 56-57 include allowable subject matter. Applicant reserves the right to amend one or more of those claims into independent form as may be considered desirable later.

In the current non-final Office Action, however, claims 42, 44, 50, 55, 58 and 60 were rejected as allegedly anticipated by U.S. Patent No. 5,273,519 to Koros et al. Reconsideration of these rejections in light of the following is respectfully requested.

**Koros Does Not Anticipate Claims 42, 44 and 50**

In its analysis of Koros, the Office Action asserts that the movable handle or trigger portion 20 of Koros corresponds to the recited "plate member" of independent claim 42. Further, it suggests that the recited "aperture" of the claim is found in the recess 21 of that handle portion 20 that accommodates a roller on the end of a leaf spring.



Claim 42 recites that its plate member is to pivot around one edge. Koros' handle portion 20, however, does not pivot around one edge, but instead pivots around a point in its middle (fulcrum F), shown in the reproduction of part of Koros' Figure 6 (left). That fulcrum is not at a top edge (e.g. where handle portion 20 connects to item 170) nor at a bottom edge. It is also between the side edges of the handle

portion 20. Claim 42 recites a plate member with two edges opposite each other, and a shaft connected adjacent one edge to pivot the plate member around the second edge. There is no pivoting of Koros' handle 20 around any edge, and no shaft connected to the handle 20 adjacent an edge to pivot it around any opposite edge. If item 30 is a "shaft," then the top end of handle 20 is the adjacent "edge." Handle 20 does not and cannot pivot around the opposite edge, which is the end below the number 20 in the drawing reproduction above.

Likewise, Koros' recess 21 does not and cannot allow insertion of an implant, as is recited of the aperture in claim 42. The tip of Koros' device (12 in Figure 6, not seen in the above reproduction) is inserted into a patient, but the handle does not enter or come near the skin. Recess 21 faces away from the patient. There is no disclosure in Koros of an implant inserted into recess 21, and a practical view of the device's use shows that an implant cannot be inserted into it, because of its distance from and orientation with respect to the patient. Recess 21 also is not open with one position of handle portion 20 and closed with another such position. Rather, recess 21 must always be open to allow sliding of roller 44 within it. If recess 21 is closed, then the roller cannot roll within it, and the Koros device will not operate as described.

For at least these reasons, Koros does not show or suggest all of the features of independent claim 42. Claims 44 and 50 depend from claim 42, and are also not anticipated by Koros on at least that basis.

#### Koros Does Not Anticipate Claims 55, 58 and 60

Each of independent claims 55, 58 and 60 recite substantially the same features discussed above with respect to claim 42. That is, each recites a plate member with opposite edges, a shaft

adjacent one edge to pivot the plate around the other edge, and an aperture through the plate having a relatively open position for insertion of an implant and a relatively closed position. The parts of Koros that the Office Action associates with the recited plate member (handle portion 20) and the recited aperture (recess 21) do not correspond with the recited structures and their interrelationships.

Further, each claim provides an additional feature that is not found in the Koros reference. Claim 55 recites that the aperture is tapered. Recess 21, however, appears to have a planar bottom (to the left as viewed in Koros' Figure 6) and side surfaces perpendicular to that bottom, with a concave rounding between them. No part of that recess is tapered. The word "taper" is only used in Koros to refer to aspects of shafts 30 and 35 and a "flare" 26 on "barrel" 25. Perhaps most importantly, if the sides of recess 21 were tapered, the ability of recess 21 to retain roller 44 would be lessened or eliminated. Roller 44 would find it much easier to escape from recess 21 along a tapered side acting as a ramp, as opposed to the disclosed sharp edge.

Claim 58 recites that the plate includes a roughened surface adjacent the aperture. The entirety of the inner surface of handle portion 20 is smooth, as seen in Koros' Figure 6.

Claim 60 recites that the plate includes a rounded surface that facilitates pivoting of said plate. The portion of handle 20 that enables the pivoting is the middle portion through which the fulcrum F (see reproduction of part of Koros' Figure 6, above) extends. That part of handle portion 20 is a square hole, with a planar bottom and perpendicular sides. Any rounding between the bottom and sides is well away from the fulcrum and has no effect on pivoting. While the bottom end of handle 20 appears to be rounded on one side, that rounding likewise has no effect on pivoting, which is exclusively governed by the fulcrum F.

Additional Comments

It appears that remarks made in prior responses in this case are applicable to the pending Office Action. Thus, in addition to the remarks above, prior responses are incorporated by reference to the extent applicable to this use of the Koros reference.

Respectfully, according the United States Court of Appeals for the Federal Circuit, language in the claim must be considered, including functional language, in a patentability determination. Such precedent includes *In re Swinehart*, 439 F.2d 210, 212, 169 USPQ 226, 228 (CCPA 1971) and *In re Ludtke*, 441 F.2d 660, 663-64, 169 USPQ 563, 565-567 (CCPA 1971). It is impermissible to ignore meaningful language in a claim. See *Perkin-Elmer Corp. v. Westinghouse Elec. Corp.*, 822 F.2d 1528, 1532, 3 USPQ2d 1321, 1324 (Fed. Cir. 1987). The MPEP agrees: "[a] functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used." MPEP 2173.05(g).

The cases the Examiner cited do not appear to support the analysis in the Office Action, and moreover, the later-decided *Swinehart* and *Ludtke* cases counsel consideration of functional language. *In re Casey* (cited by the Examiner) is a case in which functional language was considered, but the function was found to be inherent in the reference. In this case, the Office Action has not met the initial burden of demonstrating that a relied-on function is at least inherent in a reference. See *In re Schreiber*, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997).

Respectfully, the applicable law requires consideration of functional language in a claim for patentable weight. A rejection is proper only when the PTO can meet its burden to find explicit or inherent disclosure of the functional language, and in that case the burden shifts to the

applicant to show that the function is not present in the reference. Ignoring functional statements in claims is not permitted under established law.

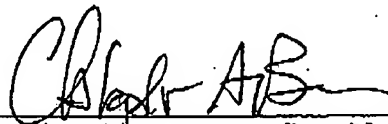
It is also noted that, as discussed above, the Koros device cannot be used to perform the functions recited in the claims. To the extent that the "ability to perform" standard is believed by the Examiner to be appropriate, respectfully that standard is not met in this case.

### Conclusion

No amendments to the claims have been made, and no narrowing of any claim by way of the above remarks is intended. It should be understood that the above remarks are not intended to provide an exhaustive basis for patentability or concede the basis for the rejections in the Office Action but are simply provided to address the rejections made in the Office Action in the most expedient fashion. Applicant reserves the right to later contest positions taken in the Office Action that are not specifically addressed herein.

In conclusion, reconsideration and withdrawal of the rejections of the claims based on the remarks presented is respectfully requested. The undersigned attorney invites Examiner Priddy to call to discuss any further issues that may remain.

Respectfully submitted,

By 

Christopher A. Brown, Reg. No. 41,642  
Woodard, Emhardt, Moriarty,  
McNett & Henry LLP  
111 Monument Circle, Suite 3700  
Indianapolis, Indiana 46204-5137  
(317) 634-3456

4002-3438.502267

---

RESPONSE TO NON-FINAL OFFICE ACTION  
Application Serial No.: 10/789,610  
Atty. Docket No.: 4002-3438  
Page 22 of 22